REMARKS/ARGUMENTS

Claim 4 is deleted and 7-10 are added. Claims 1-3 and 7-10 are now active in the application.

New Claims 7-9 correspond to deleted Claim 4 wherein each of the 3 dependent alternatives from Claims 1-3 recited are rewritten as single dependents from each of Claims 1-3. New Claim 10 depends from 7 and is specific to the named components. It finds basis in the last paragraph on page 9.

The specification is amended at page 4, typed line 12, in the paragraph starting at line 11, and also in the last line thereof for ease of reading. No new matter is supplied.

CLAIM/SPECIFICATION OBJECTIONS

In view of the deletion of Claim 4, the objection to that claim under 37 C.F.R. § 1.75(c) is now moot.

Reconsideration and withdrawal of the objection to the usage of the plural term "pitavastatin" in the specification is requested.

The use of the plural form of the term is equivalent to the generic sense of the term to designate a class of compounds. Thus one speaks of "the alcohols" and the "ethers" where a term is used both generically and also used specifically to refer to ether or alcohol itself.

However, the specification is amended at page 4, line 12, to insert the word "compound" to emphasize the specific use of the term "pitavastatin".

Claims 1, 2, 5 and 6 are amended to singularize "pitavastatin" and insert the article "a" to emphasize that one of the pitavastatin class of compounds is being specified, as is implied by the original usage of the term to designate a class of compounds.

Reconsideration and withdrawal of the rejection of Claims 1-3, 5 and 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention are requested.

The suggestions for overcoming the stated rejection relating to indefiniteness have been adopted.

With respect to Claim 6, the host is specified as "a patient in need of such treatment".

Reconsideration and withdrawal of the rejection of Claims 1-3, 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura et al. (Int. J. Clin Lab. Res. Reference cited by applicants) in view of Applicants' acknowledgement at page 4, line 13 - page 5, line 1 of the specification and Fujikawa et al. (U.S. Patent No. 5,856,336, cited by Applicants).

The Official Action states that Nakamura et al. teach a combination of an HMG-CoA reductase inhibitor, such as pravastatin and eicosapentaenoic acid or its ethyl ester, as being effective for treating hyperlipidemia and shows that the combination effectively reduces plasma levels of total cholesterol and triglycerides (see the abstract, page 22, col. 2, third paragraph under "Introduction" and page 24, the entire second under "Discussion").

However, Nakamura et al. (1) do not disclose the here recited pitavastatin compounds, as the Official Action notes.

(2) In fact, Nakamura et al. discloses only the treatment with EPA ethyl ester of patients already in a regimen of HMG-CoA reductase inhibitor treatment, where (3) just two such inhibitors are disclosed.

It is evident therefore that the Nakamura reference to the class of "HGM-CoA reductase inhibitors" is based upon a disclosure of just two such inhibitors. That constitutes an insufficient basis upon which to support a generalization relating to the characteristics of the entire class.

In any event, Nakamura et al. disclose treatment with EPA of patients already being treated with the reductase inhibitor and do not disclose the effect of the individual therapeutics on subjects prior to treatment. Hence, there is no basis for concluding that an unexpected result is achievable by a combination of the specific reductase inhibitors (here recited and not disclosed by Nakamura) of Fujikawa et al. with EPA ester or equivalent.

With respect to the remarks in the Official Action relating to the data at pages 8-10, the following is noted.

(a) The conclusion that the results are synergistic, is factually supported, witness Fig. 1, to which Applicants refer at page 10. As detailed in the second paragraph on page 10, a statistical procedure was followed to establish that there was less than one chance in 100 ($p < 0.01$) for the combination of therapeutics to yield the result reported which is therefore significantly different from application of pitavastatin alone, confirming the synergistic effect. A discussion of Durnett's multiple comparison test appears on pages 142-145, of Remington, The Science and Practice of Pharmacy, 20th Ed. 2,000, copies attached.

(b) The implied requirement that Applicant explain what the skilled artisan would have expected from the combination assumes that the prior art explicitly suggests the combination, which is not in fact the case.

(c) The requirement that Applicants carry out an extensive testing procedure would appear to be unjustified for the reason again that the Official Action reads more into the Nakamura et al. disclosure than is present there. To amplify further, the patients referred to by Nakamura et al. were in pravastatin or simvastin treatment regimens. Both those compounds are naphthalene derivatives. Please see col. 6 and 10 of the Niddam-Hilderskeim et al. patent, U.S. 6,777,552. The pitavastatins are heteroaromatic derivatives, in particular phenyl substituted quinoline derivatives, and it is not all established that the Nakamura et al. generalizations apply to them.

In any event, it would appear that it is sufficient for Applicants to demonstrate appropriately superior results for the claimed invention. The requirement that Applicants carry out research on other possible combinations of therapeutics is not supported by legal citation. The Nakamura et al. reference, as a whole, does not suggest the desirability of the here claimed combination of therapeutics.

The Fujikawa et al. compounds are sufficiently different from those of Nakamura et al. that their generalizations extended to include them are clearly speculative. The mode of action or interaction of the therapeutics is a subject of study. The results of a research program should not be denied unobviousness because the program is successful.

It finds no basis for, example, in the recent CAFC decision of Knoll Pharmaceutical Co. v. Tevo Pharmaceuticals USA, Inc., 367 Fed.(3d) 1331, 70 USPQ 2d, 1957, USPQ copy enclosed, where the only experimental date that needed to be considered was that relating to the patentee's own combination.

In summary, Applicants point out that in Nakamura et al., it is reported that after the repeated administrations of one of two specified statins (30 $\pm$ 6 months), EPA was further administered to a subject, with the result that TC and TG in blood were significantly lowered when compared to the case where only statin was administered. Firstly, since Nakamura does not disclose or suggest the use of pitavastatin, this reference does not anticipate the present invention. Secondly, it should be noted that there is no data in Nakamura showing the effect of sole administration of statin or EPA, such data being necessary to judge whether any synergic effect of using both components exists or not. Hence, Nakamura reference cannot be a ground of rejection that the synergic effect of pitavastatin and EPA was known to a skilled artisan. Clearly, Nakamura et al. does not anticipate or render obvious the present invention, in which pitavastatin is used in combination with EPA.

New Claims 7-10 are dependent from above considered claims and are similarly urged to be allowable.

Favorable reconsideration is solicited.

Respectfully submitted,

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